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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,623	12/04/2003	Andre Luiz Arias	01952.0052-01	5744
7590 08/04/2004 Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. 1300 I Street, N.W. Washington, DC 20005-3315			EXAMINER SCHILLING, RICHARD L	
			ART UNIT 1752	PAPER NUMBER

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,623

Applicant(s)

Arias et al

Examiner

RL Schilling

Group Art Unit

1752

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-54 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-54 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☒ The drawing(s) filed on 12-4-03 is/are acceptable ~~objected to~~ by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) (10/726,623) ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

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1. Claims 2, 21, 43 and 44-52 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In claim 2 the meaning of the term "mutually exclusive regarding IR absorbing/converting compounds . . . pigment" is indefinite. In claim 21, the term "basically comprising" is indefinite. \Is "comprising", "consisting essentially of" or "consisting of" intended? In claims 43 and 44 the term "structure B as prepared . . . process claims 1-42" is indefinite since claims 1-22 are not process claims. In claim 45 there is no clear antecedent basis for the term "the binding polymer" since parent claims 1 and 23 do not clearly set forth binding polymers. The intended scope of claim 53 is indefinite since it refers to any assembly or process as described in the specification which could include assemblies and processes in the cited prior art patents referred to in the specification. It is indefinite as to whether or not applicants intend to claim assemblies or processes as recited in prior art patents referred to in the specification. Even if limited to non-prior art assemblies or processes, the claim lacks clear boundaries.

2. Claims 10-13, 16, 19, 30, 38 and 54 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for

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failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claims 10-13, 16, 19, 30, 38 and 54 contain the trademark/trade names as identified in claims 10, 16, 19, 30, 38 and 54. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. § 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves.

Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade names are used to identify/describe the active compound of claims 10, 16 and 30, the pigments of claims 19 and 38 and the additives of claim 54 and, accordingly, the identification/descriptions are indefinite.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in

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public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23, 30-34 and 42-54 are rejected under 35 U.S.C. 102(b) or (e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pattel et al. '811. Pattel et al. '811 (see particularly column 2, line 58 - column

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3, line 12; column 5, line 60 - column 6, line 14; column 8, line 56 - column 9, line 61; column 10, lines 25-44; the Examples) disclose thermally sensitive materials comprising substrates, including lithographic metal substrates, a first polymer layer, including phenolic resins soluble in aqueous alkaline solutions, and a second polymer layer insoluble in aqueous alkaline solutions. The elements also comprise photothermal conversion materials, e.g. infrared absorbers. Areas that are heated are removable in aqueous alkaline developer. The second polymer layer is applied using a solvent that is not a solvent for the first polymer layer.

3. Claims 1-24, 28-39 and 42-54 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hauck et al. '494. Hauck et al. '494 (see particularly column 2, lines 25-55; column 5, lines 20-33; column 7, lines 34-47; column 8, line 6 - column 9, line 5; column 11, line 15 - column 12, line 24; the Examples) discloses thermally sensitive materials comprising substrates, first polymer layers, including phenolic resins, soluble in alkaline solution and a second polymer layer insoluble in alkaline solution. The second polymer layer may be applied by immersing the first polymer layer in solutions comprising solvents that are not solvents for the first polymer layer.

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Infrared absorbers are also present. Heated areas are removable in aqueous alkaline developer. If Hauck et al. do not anticipate the instant claims, then it would at least be obvious to one skilled in the art to use polymer material and concentrations of the two polymers to make thermally imageable elements with the disclosed properties in Hauck et al.

Claims 25-27 are not rejected over Hauck et al. since the immersion coating in Hauck et al. is not disclosed at temperatures of 50-120°C as required in instant claims 25-27. The Examples in applicants' specification show that immersion temperatures and times have significant effects on the resulting thermally sensitive materials.

5. Hauck et al. '238 is cited of interest in the art as disclosing thermally imageable elements with two polymer layers.

Hauck et al. '669, Van Damme et al. and Vermeersch et al. are cited of interest in the art as being U.S. equivalents to foreign patent publications cited by applicants. Shimazu et al., Verschueren et al. '517 and Verschueren et al. '336 are cited of interest in the art as disclosing heat sensitive elements for making lithographic printing plates comprising two polymer layers. Deroover et al. is cited of interest in the art as disclosing heat sensitive elements with aqueous alkaline soluble polymer layers and insoluble top layers.

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6. Claims 1-54 are rejected under the first paragraph of 35 U.S.C. § 112 as being based on insufficient disclosure. The specification fails to show one skilled in the art how to make and use thermally sensitive imaging elements as set forth in the instant claims with active compounds capable of rendering the first polymeric material insoluble to aqueous alkaline developer other than active compounds which are polymers insoluble to aqueous alkali developer. The specification is limited to showing one skilled in the art how to make elements wherein the first polymer layer soluble in aqueous alkaline solution is coated at its surface with a second polymer which is insoluble in aqueous alkaline developer.

7. The prior art cited in the Information Disclosure Statement, filed April 30, 2003, and the parent application has been considered and is being made of record herein.

8. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

July 30, 2004

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 1100 1752

